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08/656,811

SERIAL NUMBER	FILING DATE	FIRST NAMED APPLICANT	ATTORNEY DOCKET NO.
08/656,811	06/03/96	BARTSCH	508857JPW/JM

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EXAMINER	
DUFFY, F	
ART UNIT	PAPER NUMBER
1645	15

DATE MAILED: 02/18/99

Below is a communication from the EXAMINER in charge of this application

COMMISSIONER OF PATENTS AND TRADEMARKS

### ADVISORY ACTION

#### ☒ THE PERIOD FOR RESPONSE:

- a) ☒ is extended to run 6 months or continues to run \_\_\_\_\_ from the date of the final rejection
- b) ☐ expires three months from the date of the final rejection or as of the mailing date of this Advisory Action, whichever is later. In no event however, will the statutory period for the response expire later than six months from the date of the final rejection.

Any extension of time must be obtained by filing a petition under 37 CFR 1.136(a), the proposed response and the appropriate fee. The date on which the response, the petition, and the fee have been filed is the date of the response and also the date for the purposes of determining the period of extension and the corresponding amount of the fee. Any extension fee pursuant to 37 CFR 1.17 will be calculated from the date of the originally set shortened statutory period for response or as set forth in b) above.

☐ Appellant's Brief is due in accordance with 37 CFR 1.192(a).

☒ Applicant's response to the final rejection, filed 2-5-99 has been considered with the following effect, but it is not deemed to place the application in condition for allowance:

1. ☒ The proposed amendments to the claim and/or specification will not be entered and the final rejection stands because:

- a. ☒ There is no convincing showing under 37 CFR 1.116(b) why the proposed amendment is necessary and was not earlier presented.
- b. ☒ They raise new issues that would require further consideration and/or search. (See Note).
- c. ☐ They raise the issue of new matter. (See Note).
- d. ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal.
- e. ☒ They present additional claims without cancelling a corresponding number of finally rejected claims.

NOTE: The new claim is drawn to depressing cAMP responsive gene expression. All previous claims required an increased amount of cAMP responsive gene expression. Thus, new claims would require a new search and new rejections and further considerations

2. ☐ Newly proposed or amended claims \_\_\_\_\_ would be allowed if submitted in a separately filed amendment cancelling the non-allowable claims.

3. ☒ Upon the filing an appeal, the proposed amendment ☐ will be entered ☒ will not be entered and the status of the claims will be as follows:

Claims allowed: \_\_\_\_\_

Claims objected to: \_\_\_\_\_

Claims rejected: 1, 3-6, 15-16, 18-22

However:

☒ Applicant's response has overcome the following rejection(s): misspelling of inhibiting in claim 15, 112<sup>nd</sup> under defect

4. ☒ The affidavit, exhibit or request for reconsideration has been considered but does not overcome the rejection because no means has been taught for "memory formulation" as alleged by applicants. Memory includes long & short term and the claims are not limited to memory formulation. The enablement rejection is maintained because the claims are not limited to memory formulation and not limited to particular structural sequences, moreover

5. ☐ The affidavit or exhibit will not be considered because applicant has not shown good and sufficient reasons why it was not earlier presented.

☐ The proposed drawing correction ☐ has ☐ has not been approved by the examiner.

☐ Other  
PATRICIA A. DUFFY  
PRIMARY EXAMINER

As to the rejection under 102(a)(1) the claims have no claimed specific structure and thus applicant's allegation that they are different is not persuasive. No claims are limited by structure.

considered as such, etc. The rejections are maintained for reasons made of record. Bartsch et al. is not persuasive to remove the enablement re. because it is drawn to slowing neurons thus not compensation.